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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/779,405  | 02/12/2004  | Sean P. Kyne         | MAT 319             | 7763             |
| 23581   | 7590        | 07/14/2006           | EXAMINER            |                  |
| KOLISCH HARTWELL, P.C.<br>200 PACIFIC BUILDING<br>520 SW YAMHILL STREET<br>PORTLAND, OR 97204 |             |                      | LOWEN, ALYSSA       |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3711                |                  |

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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|                              |                               |                             |  |
|------------------------------|-------------------------------|-----------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/779,405 | Applicant(s)<br>KYNE ET AL. |  |
|                              | Examiner<br>Alyssa M. Lowen   | Art Unit<br>3711            |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/24/04</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of Group I in the reply filed on 4/24/06 is acknowledged.

***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 5/24/04 is in compliance with the provisions of 37 CFR 1.97 and 37 CFR 1.98. Accordingly, the information disclosure statement is being considered by the examiner.

***Priority***

3. Applicant's claim for the benefit of a prior-filed application (60/447054) under 35 U.S.C. 119(e) is acknowledged. Applicant has complied with all conditions for receiving the benefit of an earlier filing date.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dods (5758777) and Goldfarb (6306470). Dods discloses a toy set having a toy figure depicting a character (12) and a panel (14) depicting an image of the character (Fig. 2) that is configured as part of a base for the toy figure (Fig. 2). The toy set is packaged with a transparent wrapper (100) allowing the figure and panel to be visible (Fig. 3).

The device of Dods discloses the basic inventive concept, substantially as claimed, with the exception of the panel being a lithophane panel. Goldfarb discloses a lithophane panel (Fig. 1) that can be held in a transparent container so the image can be seen when backlit (abstract). It would have been obvious to one of ordinary skill in the art to modify the panel of Dods to include a lithophane panel in order to create an image of extreme beauty and delicacy so as to be pleasing to an observer (column 1 lines 16-30).

6. Claims 5-8 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dods (6152298), Lapides (3173540) and Goldfarb. Dods discloses a backing sheet (22) with a toy (14) and panel (12) associated with the backing sheet (Fig. 1) by a transparent cover blister (Fig. 2) that substantially encloses the toy and panel (Fig. 1). A toy support blister (18) supports the toy and is located such that the panel is located between the support and cover blisters (column 6 lines 15-21). A panel support blister (30) is disposed between the panel and the backing sheet (Fig. 2). Both support blisters support the panel (Fig. 2). The panel includes an image that is associated with the toy (Fig. 1). The device of Dods discloses the basic inventive concept, substantially as claimed, with the exception of the backing sheet having an aperture with which the panel is aligned and the panel being a lithophane panel. Lapides discloses packaging for an object having a cover and backing sheets (Fig. 3) with apertures (12) formed therein and in which is aligned an object (Fig. 1), showing this feature to be old in the display packaging art. It would have been obvious to one of ordinary skill in the art from the teaching of Lapides to include an aperture in the backing sheet of Dods in order to

not hinder a potential purchaser's view of the item while still in the packaging. Goldfarb discloses a lithophane panel (Fig. 1) that can be held in a transparent container so the image can be seen when backlit (abstract). It would have been obvious to one of ordinary skill in the art to modify the panel as disclosed by Dods to include a lithophane panel in order to create an image of extreme beauty and delicacy so as to be pleasing to an observer (column 1 lines 16-30).

7. Claims 9-10 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dods, Lapides and Goldfarb as applied above and further in view of Dods (5758777). The references disclose the basic inventive concept substantially as claimed, with the exception of the toy being a character figure with the panel including a representation of the figure. Dods (5758777) discloses a packaged toy having a toy figure depicting a character (12) and a panel (14) depicting an image of the character (Fig. 2) that is configured as part of a base for the toy figure (Fig. 2). It would have been obvious to one of ordinary skill in the art from the teaching of Dods to have the toy and panel image representative of a character figure in order to create an interesting comic collectable.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dods (6152298), Lapides and Goldfarb. The references disclose the basic inventive concept, substantially as claimed, with the exception of including a plurality of toys and panels. It would have been obvious to one of ordinary skill in the art to multiply the number toys and panels, since such a modification would have involved a mere duplication of parts.

A duplication of parts is generally recognized as being within the general skill of a worker in the art. See *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dods (6152298), Lapides, Goldfarb and Mickelberg (5289916). The references disclose the basic inventive concept, substantially as claimed, with the exception of having an indication that the panel is viewable when backlit. Mickelberg discloses including instructions or indicia on packaging to alert a person to features available from the toy while still packaged (Fig. 1). Although the reference does not expressly teach an indication that a panel is viewable when backlit it teaches providing instructions to a potential consumer on the packaging.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Lowen whose telephone number is 571-272-2684. The examiner can normally be reached on M-F (8-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



EUGENE KIM  
SUPERVISORY PATENT EXAMINER

Art Unit: 3711

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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